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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,271	02/28/2000	Raymond Senez	1782-014-999	9338

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JONES DAY
222 EAST 41ST ST
NEW YORK, NY 10017

EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/514,271

Applicant(s)

SENEZ, RAYMOND

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This communication is in response to amendment filed 1/30/03.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/2/04 has been entered.

Response to Amendment

3. Claims 1 and 14 have been amended per request.

Response to Arguments

4. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

Statute Cited in Prior Action

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

6. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen et al. (US Pat. 6,289,322) (hereafter Kitchen) and further in view of Remington et al. (US Pat. 6,070,150) (hereafter Remington).

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7. Claim 1: Kitchen discloses a system for the automated payment of bills comprising:

(a) a bill processing server connected to a network (CF Station, Fig. 2, network 100);

(b) one or more financial institution servers connected to said network, wherein a client has at least one banking account associated with at least one of said one or more financial institution servers and a biller has at least one banking account associated with at least one of said one or more financial institution servers (FI station 130a-c, Fig. 2, col. 8 L 46-55, refer to checking accounts maintained by ..payors, and deposit accounts maintained by billers, FI stations also connected to network 100);

(c) one or more biller servers connected to said network, wherein said client has at least one billing account associated with at least one of said one or more biller servers (Biller stations 110a-d, since billers are service providers and merchants issuing bills to clients (payors) billing account of client is inherent);

(d) at least one client computer connected to said network (Payor station 120a-d);

wherein said one or more biller servers includes means to format bill information and bill payment instructions associated with said at least one billing account (col. 6 L 29- col. 7 L 5 formatted billing information is provided to the CF station by the respective biller, this information is required in order that billing information be presented in the same form "as has been provided to the client in hard copy");

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and wherein said bill information further includes means for initiating bill payment instructions (detailed billing information ..terms and conditions, col. 7 L 1-5, Fig. 2B and col. 8 L 56-67, payment instruction);

and wherein said at least one client computer comprises a processor, communication means, a server access program and a display for receiving and viewing from said one or more biller servers said bill information, and input means for selecting said means for initiating bill payment instructions (col. 7 L 36-51 "exemplary payor station");

and wherein said processor integral to said at least one client computer is responsive to said input means and causes said communication means to communicate said bill payment instructions to said bill processing server when said means for initiating bill payment instructions is selected (col. 7 L 37-60, A network interface (NI) 455 interconnects the payor station 120 to the network 100.., Messages transmitted by the CF station 140 to the payor station 120 are received via the network interface 455 and processed..request the available billing related information from the CF station);

and wherein said bill processing server causes a selected one of said at least one client banking account to be debited and a selected one of said at least one biller banking account to be credited, upon receipt of said bill payment instructions (col. 8 L 46-67, ..the payment instructions are received and processed by the processor 410 of the CF station 140. ..the processor..directs the payment of the applicable bills ..by electronic funds transfer, col. 9 L 1-15, CF processor generates electronic funds transfer instructions);

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and wherein said bill processing server reports to a selected one of said one or more biller servers a selected one of said at least one billing account associated with said biller and a credit amount (col. 9 L 15-29, remittance advice information..directly to the biller station 110a-110d.);

and wherein said bill processing server reports to a selected one of said at least one client computer a selected one of said at least one billing account associated with said client and a debit amount (refer to Fig. 13 status (1335)).

(Please also refer to comments/response of the examiner under "Response to Arguments" section above).

Kitchen fails to teach that the client computer comprise a processor, communication means, a server access program and a display for receiving and viewing the bill information said bill servers **and not from said bill processing server.**

In the same filed of endeavor, however, Remington teaches a system for automated payment of bills. Remington teaches a client computer (consumer computing unit 114) which receives bill information and payment and remittance information directly from the biller servers and not from a bill processing server. The client computer comprises all required elements including processor, communication means, a server access program and a display for receiving and viewing the bill information (see Fig, 4 and 5 and description at col. 7 and 8)

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the Kitchen bill payment

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system as discussed before to provide the client computer which enables direct access to the biller server such that the bill information is received without the intervention of the bill processing server because this would enable the billers to directly send the bill information and corresponding remittance information to their customers circumventing costly service fees of third parties.

Claim 2 and 15. The system of claim 1 further including a database integral to said bill processing server for correlating said at least one client billing account stored in said bill payment instructions with a unique alphanumeric identifier assigned to said client and stored in said bill processing server, wherein said client is identified by said bill processing server when said bill payment instructions are received by said bill processing server and wherein and wherein said client confirms said bill payment instructions (col. 6 L 29 - 59, biller data 420a and payor data 420b different portions of the ..bill information are stored ..with a respective identifier of the appropriate payor).

Kitchen and Remington fail to disclose that a confirmation message is sent to said client upon identification of said client, and the client confirms bill payment instructions prior to said bill processing server debiting and crediting said client and biller banking accounts respectively .

Official notice is taken that sending a confirmation message to a payor before affecting the payment according to payment instructions is old and well known.

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It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate a feature of sending a confirmation message to the client (bill payor) and have the client confirms bill payment instructions prior to affecting the bill payment as claimed because it would assure that the payment is not made inadvertently and that the client verifies that he/she indeed intends to make the payment of the bill which is selected.

Claim 3. The system of claim 1 wherein information identifying said client and said biller banking accounts are stored in said bill processing server (refer to memory 420 which stores in area 420a biller data and in area 420b payor data including their respective account numbers).

Claims 4-6 and 13. Kitchen fails to disclose, however Remington teaches that bill information is a bill image presentable to said client and said means for formatting said bill information and said bill payment instructions is an HTML form (refer to linkages 226-232 etc. on Fig. 7). The World Wide Web as a network and said server access program as a web browser are discussed (col. 5).

It would have been obvious to one of ordinary skill in the art at the time of invention to format said bill information and said bill payment instructions is an HTML form because it would allow presenting the billing data on the Internet as a web page having links to the host server.

Claim 7. The system of claim 4 wherein said HTML form is contained in an e-mail forwarded by one of said one or more biller servers to a selected one of said at least one client computer (refer to Kitchen col. 7 L 52-60).

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Claim 8. The system of claim 1 wherein said means to communicate bill payment instructions is an icon (col. 13 L 64-col. 14 L 3).

Claim 9. The system of claim 4 wherein the billing image further includes a biller name, a billing account number, an invoice number, an invoice period, details of activity during said invoice period, and a total amount owed for the invoice period (refer to Fig. 11 of Kitchen).

Claim 10. Kitchen or Remington fail to teach that billing image further includes marketing banners and marketing hypertext links to information stored on said one or more biller servers.

Official notice is taken that including marketing banners and advertisement in the form of hypertext links is old and well known.

It would have been obvious to one of ordinary skill in the art at the time of invention to include marketing banners and marketing hypertext links to the billing image because it would allow targeted marketing to the clients closely related to the service providers or merchants.

Claim 11. bill payment instructions include a payment amount, a billing account number, an invoice number and a biller identification number (refer to Fig. 11 in view of icon 1120).

Claim 12. The system of claim 1 wherein said at least one client computer is a workstation, laptop, or wireless personal digital assistant (col. 7 L 18-35).

Claim 13. Kitchen fails to disclose, however Remington teaches communication between said at least one client computer and said bill processing server is in HTML form using SSL 128 bit encryption (col. 15 L 18-40).

It would have been obvious to one of ordinary skill in the art at the time of invention to utilize one of the available encryption techniques to maintain integrity of financial sensitive data communicated over a public network such as the Internet.

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System claims 14-26 have been analyzed as per corresponding method claims 1-13 respectively.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Egendorf (US Pat. 6411940) teaches an Internet billing method comprises establishing an agreement between an Internet access provider and a customer, and an agreement between the Internet access provider and a vendor, wherein the Internet access provider agrees with the customer and the vendor to bill the customer and remit to the vendor for products and services purchased over the Internet by the customer from the vendor.

Kolling et al. (US Pat. 6385595) discloses an electronic statement presentment system that allows a biller to direct a statement or invoice electronically to a consumer. The system includes a central switch computer coordinates template storage, validation, routing and message passing between billers, workstations and consumer financial institutions (CFI).

Heindel et al. (US Pat. 6304857) teaches an electronic billing system provides a set of tools for a biller to create and design a customized billing statement. The system includes a statement designer that enables the biller to create a template for the billing statement. Once the statement is designed, the biller provides the statement format and billing data to a third party billing service center, which generates the electronic billing statements in the biller-designed format and electronically distributes the billing statements to consumers.

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Schutzer (US Pat. 6292789) teaches a method and system for presentment of bills on a computer network includes a biller account hosted on a server of a bill service provider for receiving a bill file from a biller that includes bill data.

Hilt et al. (US Pat. 6,032,133) discloses an invention which relates to the field of electronic bill payment systems ("bill pay") which allow a consumer to direct their bank, an agent of their bank, or a non-bank bill pay service bureau to pay amounts owed to merchants, service providers and other billers who bill consumers for amounts owed.

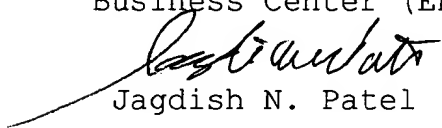
Perazza (US Pat. 5,326,959) teaches automated banking systems and means. In particular, the invention relates to a Customer Initiated Entry system, in which the Bill Payer periodically completes, on a sheet of paper, information in machine-readable form regarding Bills required to be paid and transfers that form to the Payer's Bank. The sheet of paper is optically scanned, the relevant payment information read, and the transaction for transfer of data is then automatically handled by a suitable clearinghouse with prompt transfer of funds to the Biller.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

8/5/04